

REMARKS

At the time of the Office Action dated April 29, 2005, claims 1-17 were pending and rejected in this application. Claims 3-4, 8-9, and 16-17 have been amended to address informalities. Applicants submit that the present Amendment does not generate any new matter issue.

On page 2 of the Office Action, the Examiner objected to claims 4, 8-9, and 16-17 as being in improper form. In response, Applicants have amended the claims to address the form of the claims; and therefore, Applicants solicit withdrawal of the imposed rejection to claims 4, 8-9, and 16-17.

CLAIMS 3 AND 4 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C.

§ 112

On pages 2 and 3 of the Office Action, the Examiner identified perceived informalities with claims 3 and 4. Claim 3 has been amended to provide proper antecedent basis for the term "document identifier," and claim 4 has been amended to replace the phrase "wherein serializing ..." with "further comprising serializing ..." Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 3 and 4.

**CLAIMS 1-17 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON SORGE ET AL., U.S. PATENT NO. 6,613,098 (HEREINAFTER SORGE), IN VIEW OF
CHAU ET AL., U.S. PATENT NO. 6,721,727 (HEREINAFTER CHAU)**

On pages 3-6 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Sorge in view of Chau to arrive at the claimed invention. This rejection is respectfully traversed.

Although Applicants disagree that the claimed invention is obvious based upon Sorge in view of Chau, to expedite prosecution of the Application, Applicants submit that the reference to Chau cannot be properly applied against the present Application under 35 U.S.C. § 103. As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention. See M.P.E.P. § 706.02(l).

**Application No. 10/020,048 (the present application)
and U.S. Patent No. 6,721,727 (Chau) were, at the time the
invention was made, commonly owned by International
Business Machines Corporation**

Thus, under 35 U.S.C. § 103(c), the reference to Chau cannot be considered by the Examiner when determining whether Applicants' invention is obvious under 35 U.S.C. § 103. Applicants, therefore, respectfully submit that the imposed rejection of

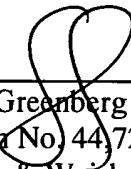
claims 1-17 under 35 U.S.C. § 103 for obviousness based upon Sorge in view of Chau is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,


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